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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,027	08/28/2003	Laurent Schaller	CSI-2008C2	1555

7590 03/08/2006
Jeffrey J. Hohenshell
710 Medtronic Parkway
Minneapolis, MN 55432

EXAMINER

HO, UYEN T

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/653,027	Applicant(s) SCHALLER ET AL.	
	Examiner (Jackie) Tan-Uyen T. Ho	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/3/05</u> | 6) <input type="checkbox"/> Other: _____ |

3DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-14 and 1-12 of U.S. Patent No. 6,945,980. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same subject matter a surgical fastener, a first needle, a second needle, flexible members coupled to needles and the ends of the surgical fastener/clip and all the limitations of the application are the obvious variants of when combines claims 13-14 of the patent to other claims of the patent.

3. Claims 1, 3-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,926,730. Although the conflicting claims are not identical, they are not patentably distinct from

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each other because they contain the same subject matter a surgical fastener, a first needle, a second needle, flexible members coupled to needles and the ends of the surgical fastener/clip and all the limitations of the application are the obvious variants of when combines claim 1 of the patent to other claims of the patent.

4. Claims 1,3-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 11-45 of copending Application No. 10/364,064 in view of Sander (5,374,268) or Totakura et al. (5,383,904). Although, the application '064 claims a surgical fastener with "a needle" attention is directed to Sander or Totakura et al. reference which discloses a surgical fastener with "two needles" to enhance the placement of the fastener. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a second needle into the assembly of application '064 in order to enhance the placement of the fastener.

This is a provisional obviousness-type double patenting rejection.

5. Claims 1, 3-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/718,236. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same subject matter a surgical fastener, a first needle, a second needle, flexible members coupled to needles and the ends of the surgical fastener/clip and all the limitations of the application are the obvious variants of when combines claim 1 of the application to other claims of the application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 3-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No. 10/340,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same subject matter a surgical fastener, a first needle, a second needle, flexible members coupled to needles and the ends of the surgical fastener/clip and all the limitations of the application are the obvious variants of when combines claim 1 of the application to other claims of the application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 3-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 67-122 of copending Application No. 10/715,797. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same subject matter a surgical fastener, a first needle, a second needle, flexible members coupled to needles and the ends of the surgical fastener/clip and all the limitations of the application are the obvious variants of when combines a claim of the application to other claims of the application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 3-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,641,593 and 6,607,541 in view of Sander (5,374,268) or Totakura et al. (5,383,904). Although, the patent '541 and '904 claim a surgical fastener with "a needle," attention is directed to Sander or Totakura et al. reference which discloses a surgical fastener with "two needles" to enhance the placement of the fastener. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a second needle into the assembly of application '064 in order to enhance the placement of the fastener.

9. Claims 1, 3-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/364,064; 10/408,019; 10/439,973; 10/985,768; 10/653,027; 11/007,825; 11/218,824 in view of Sander (5,374,268) or Totakura et al. (5,383,904). Although, the all the applications as listed claim a surgical fastener assembly with "a needle" attention is directed to Sander or Totakura et al. reference which discloses a surgical fastener with "two needles" to enhance the placement of the fastener. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a second needle into the assembly of each application as listed in order to enhance the placement of the fastener.

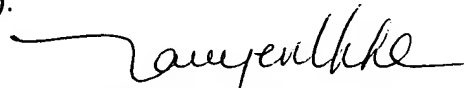
This is a provisional obviousness-type double patenting rejection.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho
Primary Examiner
Art Unit 3731

March 2, 2006